

REMARKS

Claims 26-28 and 30-44 were presented for examination in this application. The instant amendment cancels 43 without prejudice. Thus, claims 26-28, 30-42, and 44 remain pending upon entry of the instant amendment, which is respectfully requested. Claims 26 and 44 are independent.

Applicant submits that the instant amendment merely amends claim 26 to incorporate elements of claims 42 and 43, as well as cancelling claim 43. Thus, Applicant submits that the instant amendment does not require further search and consideration. Accordingly, entry and consideration of the instant amendment are respectfully requested.

Independent claim 26, as well as dependent claims 27-28, 30-33 and 38-39, were rejected under 35 U.S.C. §103(a) as over U.S. Patent No. 4,138,304 to Gantley (Gantley) in view of U.S. Publication No. 2002/0096743 to Spooner et al. (Spooner) and U.S. Patent No. 6,319,754 to Wang et al. (Wang). Dependent claims 34-37 were rejected under 35 U.S.C. §103(a) over Gantley, Spooner, and Wang in further view of U.S. Patent No. 4,828,052 to Duran et al (Duran). Dependent claims 40-43 were rejected under 35 U.S.C. §103(a) over Gantley, Spooner, and Wang in further view of U.S. Publication No. 2003/0148057 to Dietz (Dietz).

Claim 26 now recites, in part, the steps of “applying a protective layer” and “removing the protective layer after the machining step and **before** the detaching step (emphasis added)”.

The Office Action asserts, with respect to claim 41, that Gantley discloses removing a protective layer.

Gantley discloses that wafer 30 is coated with layer 32 of strippable coating. See col. 6, lines 41-42. While Gantley may disclose that coating 32 is “strippable”, Gantley

specifically discloses against removing this coating **before** the detaching step as in claim 26.

Gantley discloses that the characteristics of the coating 32 and the membrane 40 are similar, and the coating is to be considered not as an adhesive which sticks the wafer to the membrane, but rather as a material which is of like character with the membrane and, which, **upon heating of the combination, becomes part thereof, adhering more tenaciously to the membrane than to the wafer**, or subsequently, to the pellets. **When the pellets are removed from the membrane, the coating does not adhere to the pellets**, and it is not necessary to perform any additional steps for the removal of residue from the pellets. **See** col. 5, lines 15-26.

Thus, Gantley clearly requires the coating to be removed **when** the pellets are removed from the membrane and not **before** as claimed.

The Office Action asserts that the selection of any order of performing steps is prima facie obvious in the absence of any new or unexpected results by citing to *In re Burnhans*.

Applicant submits that the proposed modification of Gantley applies a **per se** rule of obviousness without providing a fact-based explanation as to why one would reasonably expect to obtain the claimed process if the order of steps in the Gantley were modified. The final rejection therefore is contrary to the holding in *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) where the court reasoned that “section 103 requires a fact-intensive comparison of the claimed process with the prior art rather than the mechanical application of one or another **per se** rule.” *Id.* at 1571, 37 USPQ2d at 1132. Stating that the court’s “precedents do not establish any **per se** rules of obviousness,” the court directed that claims should be examined “in light of all . . . relevant factors, free from any presumed controlling effect” of precedent. *Id.* at 1572, 37 USPQ2d at 1133, quoting *In re Dillon*, 919 F.2d 688, 695, 16 USPQ2d 1897, 1903 (Fed. Cir. 1990.)

Ochiai makes it clear that the obviousness inquiry does not end with the examination of precedent. 71 F.3d, at 1572, 37 USPQ2d at 1133. Rather, a proper obviousness evaluation also requires “a fact-intensive” comparison between the claims and prior art. Id. at 1571, 37 USPQ2d at 1132.

The Office Action failed to provide the required fact-intensive comparison between the claims and the prior art. Further, Applicant submits when such a comparison is made, it becomes clear that the proposed combination fails to disclose or suggest claim 26.

Gantley clearly discloses that the protective coating, upon heating, **becomes part of the membrane** and, thus, adheres more tenaciously to the membrane than to the wafer so that the coating does not adhere to the pellets **when** the pellets are removed from the membrane.

Applicant submits that one skilled in the art looking at the process of Gantley simply would not be compelled to make the modification proposed by the Office Action. Rather, Gantley specifically teaches away from such a modification.

In fact, Applicant submits that the proposed modification would render Gantley unsuitable for its intended purpose. Specifically, the only way that one could modify Gantley to provide the invention recited by claim 26 would be to modify the properties of the coating itself so that, upon heating, it does not become part of the membrane. Such a modification would clearly render Gantley unsuitable.

The Office Action fails to assert that any of the remaining cited art, namely Spooner, Wang, Duran, and Dietz, fail to cure the aforementioned deficiency noted in Gantley. Accordingly, claim 26, as well as claims 27-28 and 30-42 that depend therefrom, are in condition for allowance. Reconsideration and withdrawal of the rejection to claims 26-28 and 30-42 are respectfully requested.

Independent claim 44 was rejected under 35 U.S.C. §103(a) over Gantley, Spooner, and Wang in further view of Dietz. Applicant also traverses this rejection.

Claim 44 recites, in part, the steps of “removing the protective layer”, “**releasing the bonding force by the application of UV light**”, and “detaching the plurality of components from the carrier”.

Again, Applicant submits that Gantley fails to disclose or suggest the recited steps alone, or in combination with the cited art.

Gantley clearly requires the coating to **become part** of the membrane after heating so that it adheres more tenaciously to the membrane than to the wafer and, thus, the coating is removed **when** the pellets are removed from the membrane.

Applicant maintains that the Office Action has impermissibly used a per se rule of obviousness without the required fact-intensive comparison between the claims and the prior art. Further, Applicant submits when such a comparison is made, it becomes clear that the proposed combination fails to disclose or suggest claim 44.

Moreover, Applicant submits that modification to Gantley in the manner proposed by the Office Action would render Gantley unsuitable for its intended purpose. Specifically, the only way that one could modify Gantley to provide the invention recited by claim 44 would be to modify the properties of the coating itself so that, upon heating, it does not become part of the membrane. Such a modification would clearly render Gantley unsuitable.

The Office Action fails to assert that any of the remaining cited art, namely Spooner, Wang, Duran, and Dietz, fail to cure the aforementioned deficiency noted in Gantley. Accordingly, claim 44 is also in condition for allowance. Reconsideration and withdrawal of the rejection to claim 44 are respectfully requested.

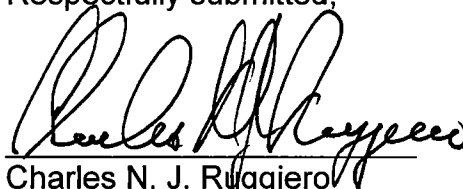
In view of the above, it is respectfully submitted that the present application is in condition for allowance. Applicant respectfully requests favorable consideration and passage of this application to issuance.

In the alternative, Applicant submits that the instant amendment places the present application in better condition for appeal. Accordingly, entry and consideration of the instant amendment, at least for the purposes of appeal, are respectfully requested.

If for any reason the Examiner feels that consultation with Applicant's attorney would be helpful in the advancement of the prosecution, the Examiner is invited to call the telephone number below.

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Respectfully submitted,



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